



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/780,485	02/12/2001	Junichi Koshiba	Q63128	8114

7590 12/11/2002

SUGHRUE, MION, ZINN, MACPEAK & SEAS
2100 Pennsylvania Avenue, N.W.
Washington, DC 20037-3202

EXAMINER

VO, HAI

ART UNIT	PAPER NUMBER
----------	--------------

1771

6

DATE MAILED: 12/11/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

AS6

Office Action Summary

Application No.

09/780,485

Applicant(s)

KOSHIBA ET AL.

Examiner

Hai Vo

Art Unit

1771

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 October 2002.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) 3-7 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2 and 8-10 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

Election/Restrictions

1. Applicant's election without traverse of Group I, claims 1,2 and 8-10 in Paper No. 5 is acknowledged. The examiner absolutely agrees that Applicants reserve the right to request rejoinder of the method claims upon indication of the product claims as being allowable.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1, 2, 8-10 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Tojo et al (US 4,877,817). Tojo discloses a foam rubber having the spring strength HS JISA which is a hardness as determined according to JIS-K-6301, and a density of 0.7 meeting the specific ranges as set forth in the claims (table 1 and column 18, line 13). Tojo is silent as to the cell diameter of the foamed rubber. However, Tojo is using the same materials such as an ethylene-alpha-olefin-non-conjugated diene copolymer rubber and a

blowing agent azodicarbonamide and the same process (blending, heating, molding, and foaming) to form the vulcanizable and foamable rubber (column 10, lines 18-50). Furthermore, Tojo teaches the foamed rubber having a Mooney viscosity meeting the required ranges as set forth in the claims. It is the examiner's position that the cell diameter would be inherently present. Note In re Best 195 USPQ at 433, footnote 4 (CCPA 1977) as to the providing of this rejection under 35 USC 103 in addition to the rejection made under 35 USC 102.

With regard to claims 8 and 10, Tojo discloses the vulcanizable and foamed rubber being useful as an electrical insulating material covering the conducting part of electrical wires (column 9, line 68 et seq. and column 10, lines 25-28). The examiner interprets that the electrical wire is analogous to a rigid body as set forth in the claims.

With regard to claim 9, Tojo is using the same materials such as an ethylene-alpha-olefin-non-conjugated diene copolymer rubber and a blowing agent azodicarbonamide and the same process (blending, heating, molding, and foaming) to form the vulcanizable and foamable rubber as Applicants (column 10, lines 18-50). Furthermore, Tojo teaches the foamed rubber having a Mooney viscosity, hardness properties and density meeting the required ranges as set forth in the claims. It is the examiner's position that the Young's modulus would be inherently present.

5. Claims 8-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tojo et al (US 4,877,817) in view of Okita et al (US 6,132,847). Tojo discloses the foamed

Art Unit: 1771

rubber can be used as a weather strip (column 10, line 8). Okita discloses a weather strip having a U-shaped grip **14** and a hollow seal **16** and a lip seal **18**, all of which are extruded from the finely foamed rubber that is formed from a foamed rubber (figures 1 and 2, column 4, lines 63-66). The examiner interprets that either the U-shaped grip or the lip seal is analogous to a claimed rigid body. The U-shaped rib 14 of Okita is inserted with a metal 12 (figures 1 and 2). It would have been obvious to one having ordinary skill in the art at the time the invention was made to employ the foamed rubber in form of a weather strip having the structure as taught in Okita because it is a typical and desirable structure of the weather strip.

With regard to claim 9, Tojo is using the same materials such as an ethylene-alpha-olefin-non-conjugated diene copolymer rubber and a blowing agent azodicarbonamide and the same process (blending, heating, molding, and foaming) to form the vulcanizable and foamable rubber (column 10, lines 18-50) as Applicants. Furthermore, Tojo teaches the foamed rubber having a Mooney viscosity, hardness properties and density meeting the required ranges as set forth in the claims. It is the examiner's position that the Young's modulus would be inherently present.

Response to Arguments

6. Applicant's arguments with respect to claims 1, 2 and 8-10 have been considered but are moot in view of the new ground(s) of rejection.
7. The 112 claim rejections and the art rejections in Paper no. 3 have been overcome by the present response.

Art Unit: 1771


Conclusion

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hai Vo whose telephone number is (703) 605-4426. The examiner can normally be reached on Tue-Fri, 8:30-6:00 and on alternating Mondays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel Morris can be reached on (703) 308-2414. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9310 for regular communications and (703) 872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

HV
December 7, 2002


TERREL MORRIS
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1700